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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,214	01/14/2005	Ralf Deisenhofer	14219-077US1/P2002,0617	1526
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FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER THOMAS, ERIC W	
			ART UNIT	PAPER NUMBER
			2831	
DATE MAILED: 09/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/522,214

Applicant(s)

DEISENHOFER ET AL.

Examiner

Eric W. Thomas

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 11, 13-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 8, 9, 12, 17, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

2. Claims 1, 4, 7-8, 19 are objected to because of the following informalities:

Claim 1, line 7, the limitation, "a terminal" is confusing. Is this terminal one of the terminals already claimed?

Claim 4, line 4, the limitation, "a component" is confusing. Is this the same component already claimed in claim 1?

Claim 7, lines 6-8, the limitation, "wherein at least part of a terminal of a top component in the stack of components is bent downwards" is confusing. Is the terminal in addition to terminals already claimed?

Claim 8, line 8, the limitation (first and second occurrence), "a terminal" is confusing. Is this terminal one of the terminals already claimed?

Claim 19, line 5, "a terminal" is confusing. Is this terminal one of the terminals already claimed?

Claim 19, line 6, "a terminal" is confusing. Is this terminal one of the terminals already claimed?

Appropriate correction is required.

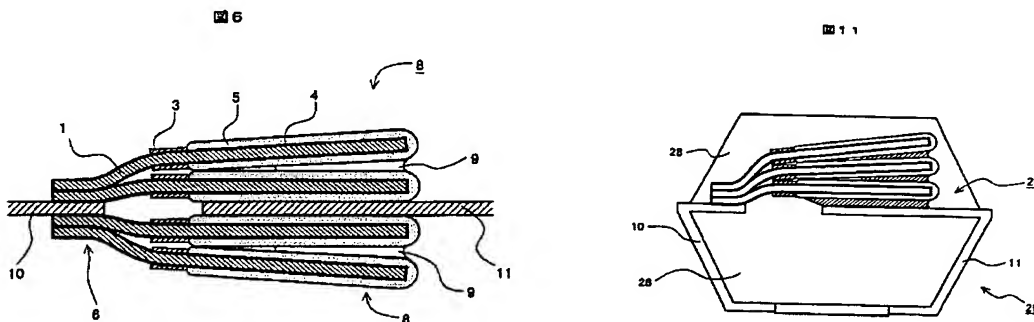
**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7, 10-11, 13-16, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakai et al. (WO 00/74091).



Sakai et al. disclose in fig. 6, & 11, a surface mounted component comprising an external contact (10); and components (fig. 6) that are arranged in proximity to each other, the components comprising terminals (1 – connected to 10) wherein the external contact is connected to at least one of said terminals (lower 1) by a spot weld, wherein the external contact defines a contact surface on an assembly area of the surface-mounted component and wherein the external contact comprises an area that is free of spot welds.

Regarding claim 2, Sakai et al. disclose the external contact is L-shaped and comprises a leg, the leg defining the contact surface.

Regarding claim 3, Sakai et al. disclose the external contact comprises the terminals.

Regarding claim 4, Sakai et al. disclose at least a part of each terminal is inside the component.

Regarding claim 5, Sakai et al. disclose the external contact and the terminals comprise separate parts of the surface-mounted components.

Regarding claim 7, Sakai et al. disclose the components are stacked vertically, wherein a base area of a bottom component in the stack of the components comprises the assembly area; and wherein at least part of a terminal of a top component in the stack of components is bent downwards.

Regarding claim 10, Sakai et al. disclose the components are arranged horizontally to form a structure; wherein a side face of the structure comprises the assembly face.

Regarding claim 11, Sakai et al. disclose the external contact comprises at least two external contacts and wherein the terminals are substantially parallel to the at least two external contacts at points where the terminals connect to the at least two external contacts.

Regarding claim 13, Sakai et al. disclose a method of manufacturing a surface-mountable component comprised of at least two external contacts that define an outer portion of the surface-mountable component, the method comprising stacking, between the external contacts components that have terminals and connecting the terminals to the at least two external contacts the terminals being connected to the at least two

external contacts by spot welding, and an area of the at least two external contacts being kept free of spot welds.

Regarding claim 14, Sakai et al. disclose the external contact is L-shaped and comprises a leg, the leg defining the contact surface.

Regarding claim 15, Sakai et al. disclose at least a part of each terminal is inside the component.

Regarding claim 16, Sakai et al. disclose the external contact and the terminals comprise separate parts of the surface-mounted components.

Regarding claim 18, Sakai et al. disclose the components are stacked vertically; and wherein at least part of a terminal of a top component in the stack of components is bent downwards.

5. Claims 1, 3, 6, are rejected under 35 U.S.C. 102(b) as being anticipated by Liepe (US 5,519,581).

Liepe discloses in fig. 1, a surface mounted component comprising an external contact (5); and components (2, 4) that are arranged in proximity to each other, the components comprising terminals (6, 8) wherein the external contact is connected to at least one of said terminals by a spot weld, wherein the external contact defines a contact surface on an assembly area of the surface-mounted component and wherein the external contact comprises an area that is free of spot welds.

Regarding claim 3, Liepe discloses the external contact comprises the terminals.

Regarding claim 6, Liepe discloses at least part of each of the terminals extends along a side of the surface-mounted component (elements 7, 8).

***Allowable Subject Matter***

6. Claims 8-9, 12, 17, 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or fairly suggest (Taken in combination with the other claimed features) a surface-mounted component comprising the anode contact that connects to one of the terminals (claim 8); wherein the components define at least one housing (claim 9); components have different electrical functions (claim 12); at least part of each of the terminals extend along a side of the surface-mountable component (claim 17); the anode contact that connects to one of the terminals (claim 19); and components have different electrical functions (claim 20).


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric W. Thomas whose telephone number is 571-272-1985. The examiner can normally be reached on Monday - Friday 5:30 AM - 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ERIC W. THOMAS  
PRIMARY EXAMINER